BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

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Appellant(s): Robert Filepp et al

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For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed January 29, 1996.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-15.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 1-29-96 has not been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellants' statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 11-15 appears on pages 50-51 of the Appendix to the appellant's brief. The minor errors are as follows:

Claims {11-15} are improperly amended subsequent to the final rejection. In particular, claim 11, from which claims 12-15 depend, contained a portion of the form "[...", which has been elided from the claims as presented for appeal, and was corrected in the after-final amendment not entered.

The scope of these claims is affected by the position of the right bracket. As listed in the appendix, however, the claims are in the form assumed for purposes of compact prosecution at final rejection, and for this Examiner's Answer.

(9)   Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,429,385   Cichelli et al   January·31, 1984

(10) New Prior Art

No new prior art has been applied in this examiner's answer. The following grounds of rejection are applicable to the appealed claims:

1.   The disclosure is objected to because of the following informalities:

In claim 11 at line 4 it appears that "system" should be plural.

Appropriate correction is required.

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2.   Claims 1-15 are rejected under 35 U.S.C. § 112, second
paragraph, as being indefinite for failing to particularly point
out and distinctly claim the subject matter which applicant
regards as the invention.

In claim 1:

At line 4 in the preamble is stated that the method of
searching involves a means such that "users can request"
(emphasis added). In light of the specification, a "locator" is
the identification of data known to the user, and terms such as
"identifier" and "code designation" are internal.

Thus part (d) is confusing because it appears to state that
a request for a record causes the generation of a code
designation, which leads to the provision of a group of locators
from which a request can be made.

It is not clear if this is an iterated request involving
other locator(s), or if "the" request for a record is a generic
request for an as yet unspecified record. In the latter case,
"the record" does not have a proper antecedent. In the former
case, a locator must be used to generate a new set of locators to
request the very record apparently already designated at the
locator level.

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In the interest of compact prosecution, a third alternative
is applied to prior art: The request to retrieve some record
prompts display of a set of locators, from which the user selects
one as a request for a specific record.

Claims 2-10 are rejected as being dependent on claim 1 and
failing to resolve the basis of the rejection.

In claim 6:

One of ordinary skill in the art understands that a record
can contain code capable of supporting interaction, and that
retrieval of a record may invoke the execution of a routine.

Nevertheless, it is not clear that a record in and of itself
can be an "interactive application", which is a process, not a
data structure. **The rejection of the prior action is maintained.**

Claims 7-10 are rejected as being dependent on claim 6 and
failing to resolve the basis of the rejection.

In claim 11:

As amended, lines 27-28 contain one left "[" and two right
"]" symbols. In the interest of compact prosecution it is assumed
in regard to prior art that the entire part (f) was to be
deleted.

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Claims 12-15 are rejected as being dependent on claim 11 and failing to resolve the basis of the rejection.

In claim 13:

The phrase "the table code identifiers" at line 2 does not have a proper antecedent. There are a number of candidates, such as "table code designation", and "application identifier" and "object identifier", but this phrase appears to imply that "table codes" have identifiers in themselves; there is otherwise no point in adding "identifiers" to "table code". **The rejection of the prior action is maintained.**

Claims 14-15 are rejected as dependent on claim 13 and failing to resolve the basis of the rejection.

In claim 15:

The phrase: "_the_ corresponding text and graphic data" (emphasis added), does not have a proper antecedent.

The phrasing: "objects which make up the application that are derived by using the identified table" is confusing.

It appears from claim 1(e) that a single application is chosen from the table, and from claim 13 that a plurality of objects can be derived from an application.

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In that context, either the application is "derived from the table" and it is singular, or that a plurality of objects are derived from <u>the</u> <u>application</u>.

The rejection of the prior action is maintained.

3.   Claims 1-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cichelli et al, USP 4,429,385, Method and Apparatus for Digital Serial Scanning With Hierarchical and Relational Access.

.   The basis of the rejection is the correspondence between the elements of the claims and the teachings of Cichelli et al (Cichelli) as detailed below.

While this maintains the rejection on the basis of Cichelli as in the prior action, the correspondence is restructured on the basis of the amendments to the claims and the Response.

In claim 1:

"A method of searching for and retrieving records included in a database provided in a computer network, the network having a plurality of reception systems at which respective users can request and retrieve respective records"

(Col 1 lines 8-31.)

"providing record locators indexed to record identifiers for the respective database records"

(Col 8 lines 43-44 and lines 55-58, where the headnote includes a record identifier. Physical record location in a stream of frames determined by a database is effected by a key which corresponds to a record identifier; col 9 lines 31-63, where the frames contain identifiers, (lines 47-51), which correspond to the locators which in turn support relational queries, (lines 36-38).

Cichelli makes it clear, at col 9 lines 1-4 and elsewhere, that the internal index is not the locator presented to the end user for menu and/or data selection. It is considered that this is the basis of the distinction between "locator" and {"record identifiers"; "group code designators"} in the claims.)

"arranging multiple locators and respective indexed identifiers in a plurality of groups, the groups respectively establishing predetermined subset searches of the database records"

(Col 9 lines 5-29, where groups are determined by menus.)

"assigning code designations to the respective locator groups"

(Col 9 lines 5-16.)

"generating a locator group code designation in response to a request for a record so that a group of record locators may be provided at the reception system and so that a locator may be selected which enables identification and retrieval of the record"

(Col 9 lines 47-63, where the identification information is

converted into an appropriate code to access the appropriate

frames.)

In claim 2:

"providing record locators indexed to record identifiers includes setting the locators as mnemonics that are indexed to the respective identifiers for the respective records in the database"

(Col 11, Example menu.)

In claim 3:

"arranging the locators in groups includes arranging the locator mnemonics in tables in which the respective mnemonics are indexed to the respective record identifiers"

(Col 11 lines 36-42, where the locators are screens of

various types, each of which is indexed to a group of records.)

In claim 4:

"assigning code designations to the respective locator groups includes establishing the respective code designations as alphabetically sequenced character strings such that when a character sequence is entered at a reception system to designate a requested record, a locator table may be provided at the reception system from which a group of respective record identifiers may be selected."

(Col 5 lines 29-31, where a newspaper's classified ads are used as an example database. It is well-known to those in the art that such advertisement sections are arranged in an alphabetical sequence. It is clear that in such a database, the sections that correspond to sub-menus would naturally be alphabetically arranged headings as they are in a newspaper.)

In claim 6:

"the records to be searched for and retrieved are interactive applications associated with an interactive service, and wherein the applications are arranged to be generated from objects"

(Col 8 lines 45-47.)

In claim 7:

"providing locator keywords indexed to respective record identifiers includes establishing the identifiers as object identifications"

(Col 8 lines 45-47, where code is retrieved, and the thrust of Cichelli as a whole, where data is the presumed target; as a combination this is an anticipation of objects even in the OOPS sense of combined data and code, applied to a suitable database.

In particular, it is noted that there is no claim of retrieving an OOPS object and then executing it within a system in which that can be done, from which the special nature of such an object is moot.)

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In claim 8:

"one of the multiple search procedures for entering the character sequence at the reception system includes entering the character sequence as a description of a desired application"

(This is addressed in Cichelli in terms of the distinction between an attribute and a keyword at col 6 lines 40-68, where varieties of entries are used to access the same attribute.)

In claim 9:

"one of the multiple search procedures for entering the character sequence includes entering the character sequence as a selection of the desired application from an alphabetical listing of applications"

(Col 11 lines 26-28 as applied to the content of claim 6.)

In claim 10:

"one of the multiple search procedures for entering the character sequence with a plurality of search strategies includes entering the character sequence as a selection of the desired application from a subject-category listing of applications"

(Col 11 example menu; this particular example can be narrowly interpreted as choices of data collections.

However, it is clearly intended to illustrate the choice of availables, which, in light of col 8 lines 45-47, can include programs.)

The elements of claims 11-15 are rejected in the analysis above, and they are rejected on those grounds.

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(13) Response to argument

Some portions of Applicants' Arguments are posed in regard
to the after-final amendment, not entered. They are thus moot and
are not responded to.

In Regard to 35 USC § 112:

As discussed at length in the Response, claims are to be
read in the light of the Specification. However, Applicant bears
the responsibility of crafting claims so that the light can be
applied without ambiguity.

Beginning at page 16, last paragraph of the Appeal Brief,
the interpretations and limitations cited are not specified by
claims 1-10; it would be highly presumptuous to read them into
the claim language as though they were definitions of terms.

The other arguments with respect to 35 USC § 112 are
considered to be adequately responded to in the rejection above.
In particular, the phrase "records included in a database" is
well known in the art, where it does not determine a specific
class of records without further limitation. **This maintains the
arguments made in the final rejection.**

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In claim 5:

The 35 USC 112.2d rejection of this claim, that records are not interactive applications, confuses the arguments in regard to claims 6-10 with respect to both prior art and 112.2d, and essentially renders them moot. This is compounded by treating the apparently same records as objects, and assuming in argument that these are necessarily OOPS objects, rather than database objects as implied by the preamble to the claims. These terms are of sufficiently common multiple use in the art that they must be carefully distinguished. In particular, a database of (OOPS) objects and an object-oriented database are not the same.

The nature of the records to which claim 5 refers greatly affects the claim scope, and could further limit the scope of the records of claim 1 to a specific category of record.

In regard to 35 USC § 102(b):

The thrust of the Argument is based on a mismatch between the Specification in complete detail and Cichelli. However, it is the claimed invention which is rejected above. As one particular, at page 25 line 3 the argument characterizes Cichelli as "non-interactive", and not Videotext. Neither is the claimed invention. Nevertheless, as noted in the rejection above, Cichelli allows a user to select a desired portion of a database, using "relational queries" (as noted at col 8 lines 52-54).

It is considered that this is just as interactive as the invention as claimed. In general, the arguments are directed to the Specification, not the claims.

In claim 1:

Consider the underlined argument at page 26, where the database is divided into subset searches. Clearly Cichelli's hierarchy does divide a database into subsets and allows searches to be focused on one of them.

The Brief, particularly at page 29 last paragraph *et seq*, argues that Cichelli does not apply because it does not apply "locators" and "identifiers" in the same way. This is addressed in the rejections above as appropriate, but the kernel of the argument fails to take into account the context of Cichelli, in which (one embodiment of) the database **is** the set of frames being broadcast. No fundamental distinction between the database of the Disclosure and as addressed in the Claims and the context of Cichelli is apparent, and it is considered moot.

At page 30 the underlined statements which claim that Cichelli does not teach anything about codes and groups ignores the cited paragraph, col 9 lines 5-16, which lays out both.

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Claim 2:

In regard to the argument on page 33 that Cichelli's screen are not "tables", it is noted that no table structure in the strict sense is applied in the claims, no row and column locators are involved, from which a table is any structure which allows one to retrieve one item in terms of another.
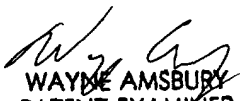

Claim 4:

The limitation that the tables are "unseen by the user and internal to the system" at page 34 line 21 is not a limitation of the claims.

In claims 6-10:

The 35 USC 112.2d rejection that records are not "interactive applications" renders the arguments moot.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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